

REMARKS/ARGUMENTS

Applicants acknowledge receipt of the Office Action dated August 7, 2006 wherein: (1) claims 1, 2, 4, 6, 9-11, and 13-16 were rejected under 35 U.S.C. § 102(b); (2) claims 3, 5, 7, 8, and 12 were rejected under 35 U.S.C. § 103(a); and (3) claims 17-35 were withdrawn from consideration.

Status of the Claims

Claims 2-16 are in original form.

Claim 1 is currently amended.

Claims 17-35 have been canceled.

Rejections under 35 USC § 102(b)***Rejections under 35 USC § 102(b) in view of Griffith***

Claims 1, 2, 4, 6, 9-11, and 13-16 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,448,206 to Griffith et al. (hereinafter *Griffith*). As explained by the Court of Appeals for the Federal Circuit: “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegall Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Amended claim 1 reads:

1. (Currently Amended) A method of servicing a wellbore in contact with a subterranean formation, comprising: displacing a sealant composition comprising a colloidally stabilized latex into the wellbore; **wherein the sealant composition does not comprise an epoxy resin.**

Support for the amending language can be found in the specification. See, e.g., Application ¶¶ [0012]-[0016] and [0018-0025] (no epoxy resin included in the sealant

composition); *see also* [0017] (no epoxy resin included in the sealant composition, rather “[i]n another embodiment, the colloidally stabilized latex may include thermosetting resins such as melamine-formaldehyde derived resins and urea-formaldehyde resins that are capable of participating in the crosslinking reactions in the presence of the acidic catalysts.”) and [0026] (no epoxy resin included in the sealant composition, rather “[t]he sealant compositions may also contain thermosetting resins such as melamine-formaldehyde derived resins, and urea-formaldehyde derived resins for improving the mechanical properties of the solid mass such as compressive strength and tensile strengths”). It is well known in the art that neither melamine-formaldehyde resins nor urea-formaldehyde resins are epoxy resins, as taught by *Griffith*.

Griffith specifically teaches the use of “epoxy resins.” *See Griffith* at col. 4, claim 1 (“An improved sealing composition for sealing a subterranean zone penetrated by a well bore consisting essentially of: an aqueous rubber latex; a latex stabilizing surfactant; *an epoxy resin*; and a hardening agent for said epoxy resin.”) (emphasis added); *see also* col. 1, line 67; col. 2, lines 8, 13, and 27; col. 3, lines 24, 57, and 63; col. 4, line 3; col. 5, line 20 – col. 7, line 6; col. 8, line 67; col. 10, lines 7–14, 33–45, 54–64 ; col. 11, lines 7–9, and 39; col. 12, lines 54–58; col. 13, lines 40–48; and col. 14, lines 25–29. The instant Application’s methods for servicing a wellbore do not teach the use of “epoxy resins.” *See Application ¶¶ [0012]-[0016] and [0018-0025].* As evidenced by amended claim 1, the instant Application teaches away from the use of “epoxy resins” in its methods for servicing wellbores involving the use of sealant compositions comprising colloidally stabilized latex. Accordingly, amended claim 1 is allowable over *Griffith*.

Because claims 2, 4, 6, 9–11, and 13–16 depend on amended claim 1; defendant claims 2, 4, 6, 9–11, and 13–16 are allowable because they are not anticipated by *Griffith*.

Rejections under 35 USC § 103(a)

Claims 3, 5, 7, 8, and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Griffith* in view of Krishanan et al. U.S. Patent No. 5,900,451 (hereinafter *Krishanan*). Thus, claims 3, 5, 7, 8, and 12 stand or fall on the application of *Griffith* to the claims. The requirements for establishing a *prima facie* case of obviousness are well established:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicants' disclosure. MPEP § 2142 citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added).

As explained in reference to the § 102(b) rejections above, *Griffith* fails to teach or suggest the limitations contained in amended claim 1. In addition, all dependent claims incorporate the limitations of the claims they depend on. Because claims 3, 5, 7, 8, and 12 depend on and; therefore, incorporate the limitations of amended claim 1, and *Griffith* fails to teach the limitations of amended claim 1, *Griffith* also fails to teach or suggest the limitations contained in claims 3, 5, 7, 8, and 12. The Office Action does not cite *Krishanan*, or other prior art references, to teach the limitations that are absent from *Griffith*. Thus, the Office Action does not establish a *prima facie* case of obviousness as to claims 3, 5, 7, 8, and 12, which are allowable over the cited prior art.

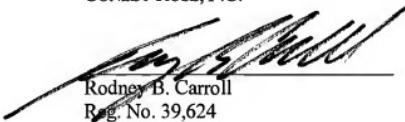
CONCLUSION

Consideration of the foregoing amendments and remarks, reconsideration of the application, and withdrawal of the rejections are respectfully requested by the Applicants. No new matter is introduced by way of the amendment. It is believed that each ground of rejection raised in the Office Action dated August 7, 2006 has been fully addressed. If any fee is due as a result of the filing of this paper, please appropriately charge such fee to Deposit Account Number 50-1515 of Conley Rose, P.C., Texas. If a petition for extension of time is necessary in order for this paper to be deemed timely filed, please consider this a petition therefore.

If a telephone conference would facilitate the resolution of any issue or expedite the prosecution of the application, the Examiner is invited to contact the undersigned at the telephone number given below.

Respectfully submitted,
CONLEY ROSE, P.C.

Date: 11-6-06



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